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OFFICE OF PETITIONS

In re Application of
Oyama
Application No. 09/988,768
Filed: November 20, 2001
Attorney Docket No. OGW-0204

: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.183

This is a decision on the petition under 37 CFR 1.183 filed November 3, 2003, styled as a petition to accord a claim for foreign priority by way of waiver of the rules, which is also being treated as a petition to waive the rules and accord the above-identified nonprovisional application a filing date of October 27, 2001, instead of the current filing date of November 20, 2001.

The petition is **dismissed.** This decision is not a final agency action.

Applicant filed an application in Japan on October 27, 2000. As such, pursuant to 35 U.S.C. 119(a), any counterpart U.S. nonprovisional application had to be filed in the U.S. within twelve months of that date, *i.e.*, on or before October 27, 2001, in order for the U.S. counterpart application to be able to claim benefit of the foreign application.

Applicant asserts that the original counterpart U. S. application papers were mailed on or about October 19, 2001, from Japan to U.S. counsel's offices with instructions to file the U.S. counterpart before the critical date. However, due to mail delays arising from from the irradiation of U.S. mail out of anthrax concerns, the original counterpart papers were not timely received by counsel's office, with the exception of the priority papers *per se*. Copies of the original counterpart papers were sent by facsimile transmission to U.S. counsel on November 16, 2001, and the copies were, in turn filed at the USPTO on November 20, 2001, which, however, is subsequent to the date required by § 119(a) as a condition of claiming benefit of the foreign filled Japanese application. Petitioner seeks waiver of the rules such that benefit of the Japanese application can be claimed.

Nevertheless, 37 CFR 1.183 is, by its terms, unavailable to waive any requirement of law. Since the instant nonprovisional application papers were not received at the USPTO on or before October 27, 2001, the 12 month filing requirement of § 119(a) is controlling and, as such, a proper claim for benefit simply cannot be acknowledged. Furthermore, the statutory 12 month time period cannot be waived by the USPTO. The

USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the USPTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 USC §§ 112, 120).

If the instant application papers could be accorded a filing date of October 27, 2001, then the 12 month filing requirement of § 119(a) could be satisfied. However, the USPTO also lacks both the discretion and the authority to accord the above-identified nonprovisional application papers a filing date earlier than their admitted date of receipt at the USPTO: November 20, 2001.

35 U.S.C. § 111(a)(4) states that:"[t]he filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office." As such, the filing date is governed by statute: November 20, 29001, the earliest date the instant nonprovisional application papers were received at the USPTO. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). Further as the filing date of this application is governed by statute, an Executive Branch agency like the USPTO must follow the strict provisions of the applicable statute. See A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977). It follows that, as above, 37 CFR 1.183 cannot be properly invoked to the contrary of the applicable statute to change the filing date of the above-identified nonprovisional application papers from November 20, 2001, to October 27, 2001.

Lastly, while the USPTO has posted various notices regarding postal emergencies stemming from the events of September 11, 2001, and the anthrax-caused mail delays, these are of no avail to petitioner. See http://www.uspto.gov/emergencyalerts/index_emergency.html. That is, 35 U.S.C. 21(a), and its implementing regulation 37 CFR 1.10, simply do not apply to the circumstances of this case. First, the remedial provisions of the aforementioned statute and regulation only apply to correspondence deposited with the USPS, or would have been deposited with the USPS, which here means the USPS itself refused, from the onset, to accept the correspondence, or that an extant postal emergency precluded such initial deposit. Here, however the instant correspondence was deposited, in Japan, with the Japanese postal service, and was not deposited with the USPS. Secondly, the correspondence must also be deposited, or attempted to have been deposited, with the Express Mail to Post Office to Addressee service of the USPS, and addressed to the USPTO (not counsel's office), a circumstance that likewise did not occur. It follows that the USPTO lacks the discretion and the authority to consider the instant application papers to have been filed with the USPTO on October 27, 2001, within the meaning of 35 U.S.C. § 21(a) and 37 CFR 1.10.

Accordingly, since the above-identified nonprovisional application papers were not filed, and cannot be considered to have been filed, at the USPTO within 12 months of the counterpart Japanese application, the requested relief cannot be favorably treated.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 305-1820.

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